

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of

O'CONNOR

Group Art Unit: Unknown

Appln. No.: New Application

Examiner: Unknown

Filed: November 19, 2003

FOR: COVERING FOR BOARDS

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November 19, 2003

**PATENT SEARCH STATEMENT, INFORMATION DISCLOSURE
STATEMENT, AND DISCUSSION OF PATENTS MOST CLOSELY
RELATED TO SUBJECT MATTER OF CLAIMS**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The undersigned hereby states that a pre-examination search was made by professional patent search personnel for prior art relevant to the claimed subject matter of the above-identified application. The search was conducted by a retired Examiner from Class 52 in the public search room of the United States Patent and Trademark Office. The areas searched included Class 52, Subclasses 181, 177, 179, 650.3, 746.1, 746.11; Class 428, Subclass 40.1; and, Class 156, Subclass 72. Examiners Knable and Yau were consulted.

The references found as a result of the search efforts are listed on the form PTO-1449 filed herewith. Additional prior art references of which Applicant was aware are also listed.

The most material prior art found from the search includes the following patents:

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U.S. Patent 4,554,194 to Haas et al. (Haas)

U.S. Patent 4,849,267 to Ward et al. (Ward)

U.S. Patent 4,695,493 to Friedlander et al. (Friedlander)

U.S. Patent 3,010,859 Stephens et al. (Stephens)

U.S. Patent 5,475,952 to O'Connor (O'Connor)

U.S. Patent 6,453,630 to Buhrts et al. (Buhrts)

The invention according to independent claim 1 is directed to a covering for use on an exterior surface comprising a fibrous layer and a moldable layer directly applied to the entire back surface of the fibrous layer and having a bottom surface with an adhesive quality. The moldable layer is applied at a volume of at least about 185 gsm, and a release sheet releasably secured to the adhesive layer. The fibrous layer, adhesive layer, and release sheet form a composite strip that is elongated with a predetermined length and a predetermined width less than the predetermined length.

Independent claim 15 expresses the invention in terms of the thickness of the moldable layer rather than the volume by reciting that the moldable layer is at least 5 mils thick.

Independent claim 30 expresses the invention by reciting a covering product for application to an upper surface each of a plurality of elongated boards. The covering product comprises an elongated strip of flexible floor covering material having a width slightly less than an elongated board, a moldable layer with an adhesive surface applied to the back surface of the strip of covering material, and a release material releasably secured to the adhesive surface. The elongated strip of floor covering material is rolled longitudinally. The release material is arranged to cooperate between the adhesive surface and the strip to allow

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unrolling of the rolled strip for application of the moldable layer to one of the elongated boards.

HAAS

Haas is directed to a self adhesive floor covering including fibers 4 secured to a bonding layer that can be mixed with adhesive 2 to provide an underside 12 that bonds with a floor 20. FIG. 4 shows a carpet in which the entire underside is covered with a layer 3 of adhesive capable of forming a bond with a floor. The layer 3 has spaced projections 11 that form a relatively firm bond with the floor while the areas between the projections 11 form a relatively loose bond. This is intended to allow for expansion and contraction of the floor, so that while the projections 11 remain firmly bonded to the floor, the areas between the projections 11 can become loosened, as explained in col. 6, lines 30-51. The four examples of the carpet in accordance with Haas' invention use adhesive applied in an amount of 35 gsm, 65 gsm, 45 gsm, and 60 gsm, respectively.

A protective foil 12 can be provided over the adhesive 2. If the carpet is supplied in a roll, the foil 12 can prevent the adjacent turns from sticking to one another. To install the carpet, as explained in col. 7, lines 24-44, the carpet is spread on the floor and cut to conform to the configuration of the floor. After the carpet is cut to size, the foil 20 is removed and the carpet is adhesively bonded to the floor. To simplify removal of the foil 12, the foil 12 may be divided into discrete strips 13 as seen in FIG. 6a. The strips 13 may be parallel to one another and may extend in the longitudinal direction of the carpet so that the strips 13 may be removed one by one in accordance with the progression of the carpeting operation so that the carpet is bonded to the floor in segments.

Claims 1 and 15 are distinct from Haas' floor covering in that the adhesive in Haas is applied as a thin layer to allow for areas to become loosened after application. Claim 1

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recites that the moldable layer with the adhesive bottom surface is applied at a volume of at least 185 gsm between the back surface of the fibrous layers and the bottom surface of the moldable layer. Claim 15 recites that the moldable layer is applied in a thickness of greater than 5 mils. These ranges are well above Haas' suggested applied volumes, which range from 35-65 gsm, and provide the secondary molding effect that characterizes this invention that is absent in Haas. Claims 1 and 15 further recite that the covering is a composite strip having a predetermined width less than a predetermined length, which differs from Haas' room size carpet. Claims 1 and 15 are patentable over Haas.

Claim 30 is distinct from Haas because Haas does not disclose a covering product for application to an upper surface of each of a plurality of elongated boards comprising an elongated strip of flexible floor covering material having a back surface and a width slightly less than the width of the elongated boards and a moldable layer with an adhesive surface applied to the back surface for direct attachment of the elongated strip to an upper surface of one of the boards. Haas merely discusses application of the covering to a floor and lacks direct attachment to a surface in that certain depressed areas of the back surface of Haas' covering will not be adhered to the floor after application. Claim 30 is patentable over Haas.

The dependent claims are also allowable for at least the reasons above and for the further features recited therein.

WARD

Ward provides a carpet that is formed with a fibrous face 12 secured to a primary backing 13 that engages a secondary backing 14 having an embossed pattern 20 with high and low areas 21, 22. A pressure sensitive adhesive 15 is applied to the secondary backing 14 in the amount of 0.5 to 1.5 ounces per square yard "to provide an acceptable level of intended tackiness and cohesiveness needed for releasably securing the floor covering 10 to the

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underlying floor.” (Col. 5, lines 45-50.) The adhesive is selected to have a low tensile strength to facilitate removal. According to the specification, aging tests that simulate releasable securement of the floor covering 10 over protracted time periods shows that the floor covering can be peeled away without having retention of the adhesive to the underlying floor or rupture of the secondary backing 14. (Col. 4, lines 10-23.)

A release cover 30 is applied over the adhesive 15 after it has dried and the floor covering is wound into a roll. The release cover 30 includes at least one longitudinal tear line 60 formed from a plurality of perforations, as explained in col. 5, line 64 – col. 6, line 7. Arrows 40 are printed on the secondary backing 14 and are visible through the adhesive 15 and the release cover 30 to indicate the direction of the pile yarns.

Claims 1, 15 and 30 are patentably distinct from Ward in that they recite that the moldable layer is directly applied to the entire back surface of the fibrous layer (claims 1 and 15) and that the moldable layer is applied to the back surface of the elongated strip of floor covering material for direct attachment of the back surface to the upper surface of an elongated board (claim 30). Ward has an intermediate foam backing 14 that would not be suitable for exterior use. Thus, Ward does not disclose a covering with a moldable layer having an adhesive quality or surface directly applied to entire back surface as claimed.

Further, claims 1 and 15 recite a much thicker layer than in Ward, which uses 0.5 to 1.5 ounces per square yard. This allows the moldable layer to mold to the surface and achieve the secondary bonding effect in accordance with this invention. Claims 1 and 15 additionally recite that the predetermined width of the composite strip is less than the predetermined length, which differs from Ward's room size carpet. Claims 1 and 15 are patentable over Ward.

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Claim 30 also recites a covering product for application to an upper surface of each of a plurality of elongated boards comprising an elongated strip of flexible floor covering material having a back surface and a width slightly less than the width of the elongated boards and a moldable layer with an adhesive surface applied to the back surface for direct attachment of the elongated strip to an upper surface of one of the boards. Ward merely discusses application of the covering to a floor and lacks direct attachment to a surface in the low embossed areas 22, which are not directly attached to the floor after application. Claim 30 is patentable over Ward.

The dependent claims are also allowable for at least the reasons above and for the further features recited therein.

FRIEDLANDER

Friedlander's peel and stick carpet assemblies are contoured to correspond to a substrate surface. The carpet assembly 2 includes a carpet layer 4, a first adhesive layer 16, a shape retention web 10, a second adhesive layer 18, and a release sheet 20. The second adhesive layer 18 is provided in a thickness between about 1 to 20 mils covering the rear surface of the web 10.

Friedlander does not disclose a covering that has a moldable layer directly applied to the entire back surface of the fibrous layer as recited in claims 1 and 15. Friedlander's contoured carpet assembly, which is used to cover shaped surfaces, is not a composite strip formed from a fibrous layer, a moldable layer with a bottom surface having an adhesive quality, and a release layer that is elongated with a predetermined width less than a predetermined length. Claims 1 and 15 are patentable over Friedlander.

Claim 30 is distinct from Friedlander's three dimensional carpet assembly as it recites a floor covering product for application to an upper surface of each of a plurality of boards

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that includes an elongated strip of flexible floor covering material having a back surface and a width slightly less than the width of the elongated boards, a moldable layer with an adhesive surface applied to the back surface of the floor covering for direct attachment to the upper surface of the elongated boards, and a release material, with the elongated strip being rolled longitudinally. Claim 30 is patentable.

The dependent claims are allowable over Friedlander for at least the above reasons and for the additional features recited therein.

STEPHENS

Stephens is directed to conventional interior floor carpet tiles. The square tiles are made of a relatively stiff felt base 11 with carpet 14 on one side and a pressure sensitive adhesive on the other. A thin paper or paper-like sheet material 15 covers the adhesive. There is no indication as to the amount of adhesive applied to the felt base 11.

In distinction, claim 1 recites a moldable layer with a bottom surface having an adhesive quality directly applied to the back surface of the fibrous layer, which differs from Stephens use of an intermediate felt layer. Also, the layer is applied thickly at a volume of at least about 185 gsm, which allows it to be moldable to effect the mating characteristic of this invention with exterior boards, to which Stevens is silent. Additionally, the claimed covering is not provided as square tiles as in Stevens, but rather is provided as a composite strip, with a predetermined length greater than a predetermined width. For at least these reasons, claim 1 is patentable over Stephens. As for claim 15, which is similar to claim 1 except for the volume of the moldable layer, Stevens does not disclose a moldable adhesive layer being at least 5 mils thick. Claim 15 is patentable over Stephens.

Claim 30 is distinct from Stephens' tiles by reciting a covering product for application to an upper surface of each of a plurality of elongated boards, comprising an elongated strip

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of flexible floor covering material having a width slightly less than the width of the elongated boards with a moldable layer with an adhesive surface and a release material with the elongated strip being rolled longitudinally. Claim 30 is patentable over Stephens.

The dependent claims are allowable over Stephens for at least the above reasons and for the additional features recited therein.

O'CONNOR

O'Connor's floor covering layer 11 for deck planks 10 includes a fibrous layer 18 bonded to a support layer 20. The layer 11 has side edges 23 and 24 that are spaced to define a width that is equal to the nominal width of a deck plank so that the side edges 23, 24 are substantially contiguous with the side surfaces 14, 15 of the deck plank. The support layer 20 has an lower arched layer 25 that has a raised central section 32. The support layer 20 also has recesses or grooves 30 that may be bent 31 upon assembly to a plank as seen in FIG. 6. The covering layer is attached to the deck plank by a single row of staples 70 applied through the covering layer along the center portion 32 so that the side edges are free from fastening to the deck, as explained in col. 6, lines 22-33.

O'Connor's cover is stapled to the plank, not formed of a fibrous layer with a moldable layer directly applied to the fibrous layer at a volume of at least 185 gsm, and a release sheet as recited in claim 1 or a fibrous layer with a moldable layer directly applied to the fibrous layer at least 5 mils thick, and a release sheet as recited in claim 15. Additionally, O'Connor's cover is not an elongated strip of flexible floor covering material with a moldable layer with an adhesive surface and release material releasably secured to the adhesive layer, as recited in claim 30. Claims 1, 15, and 30 are patentable over O'Connor.

The dependent claims are allowable over O'Connor for at least the above reasons and for the additional features recited therein.

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BUHRTS

Buhrts discloses a deck plank cover 15 that is formed of plastic/wood replacement material, as discussed in col. 4, lines 34-54. The cover 15 is attached to wooden deck planks 20 by nails, screws, adhesive or a combination of adhesive and traditional mounting means. (Col. 2, lines 60-65.)

Buhrts' rigid cover is not formed of a fibrous layer with a moldable layer directly applied to the fibrous layer at a volume of at least 185 gsm, and a release sheet as recited in claim 1 or a fibrous layer with moldable layer directly applied to the fibrous layer at least 5 mils thick, and a release sheet as recited in claim 15. Additionally, Buhrts cover is not an elongated strip of flexible floor covering material that is rolled longitudinally, as recited in claim 30. Claims 1, 15, and 30 are patentable over Buhrts.

The dependent claims are allowable over Buhrts for at least the above reasons and for the additional features recited therein.

SUMMARY

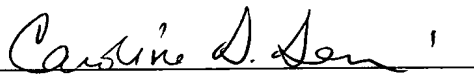
The remaining prior art is either cumulative of the prior art discussed above or so clearly distinct from the claimed covering it requires no further discussion. It is submitted that claims 1-41 define a patentable article as illustrated above. Prompt and favorable examination is requested.

Respectfully submitted,

PILLSBURY WINTHROP L.L.P.

CDD/bhs

P.O. Box 10500
McLean, VA 22102
Tel. No. (703) 905-2000

By 
Caroline D. Dennison
Reg. No. 34,494
Tel No.: (703) 905-2047
Fax No.: (703) 905-2500

Docket Number: 082018-0305657

PATENT APPLICATION

Client Reference:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of

LAWRENCE J. O'CONNOR

Group Art Unit:

Application No.:

Examiner:

Filed: November 19, 2003

Confirmation No.:

For: COVERING FOR BOARDS

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR 1.56, the attention of the Patent and Trademark Office is hereby directed to the reference(s) listed on the attached PTO-1449. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the reference(s) be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

This Information Disclosure Statement is being filed (a) within three months of the U.S. filing date of this non-CPA application, OR (b) before the mailing date of the first Office Action on the merits in the present application. No certification or fee is required.

This application is related to concurrently filed application entitled "A Method of Applying a Covering for Boards", which is directed to related technical subject matter. The identification of this U.S. Patent Application is not to be construed as a waiver of secrecy as to this application now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited application and the art cited therein during examination.

English-language Abstracts of the non-English language references are attached hereto.

Respectfully Submitted,

A handwritten signature in cursive script, reading "Caroline D. Dennison".

Caroline D. Dennison
Registration Number 34494

Date: November 19, 2003
PILLSBURY WINTHROP LLP
Telephone: (703) 905-2000
Facsimile: (703) 905-2500
P.O. Box 10500
McLean, VA 22102

Atty.
Dkt. No.

M#

Client Ref.

0305657

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT

Applicant: Lawrence J. O'CONNOR

Appln. No.: New Appln.

Filing Date: November 19, 2003

Date: November 19, 2003

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of

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Examiner:

Group Art Unit:

U.S. PATENT DOCUMENTS

Examiner's Initials*		Document Number	Date MM/YYYY	Name (Family Name of First Inventor)	Class	Sub Class	Filing Date (if appropriate)
	AR	Des. 421,502	03/2000	Felch et al.			
	BR	US 2002/0100231 A1	08/2002	Miller et al.			
	CR	US 2002/0152712 A1	10/2002	Smith			
	DR	US 2003/0079421 A1	05/2003	Yang			
	ER	2,042,692	06/1936	D.B. Wurzburg			
	FR	3,010,589	11/1961	F.J. Stephens et al.			
	GR	3,014,829	12/1961	E. Curtin			
	HR	3,135,647	06/1964	B.O. Wheeley			
	IR	3,937,640	02/1976	Tajima et al.			
	JR	4,349,593	09/1982	Blechstein			
	KR	4,554,194	11/1985	Haas et al.			
	LR	4,695,493	09/1987	Friedlander et al.			
	MR	4,988,551	01/1991	Zegler			
	NR	4,849,267	07/1989	Ward et al.			

FOREIGN PATENT DOCUMENTS

		Document Number	Date MM/YYYY	Country	Inventor Name	English Abstract		Translation Readily Available	
						Enclosed	No	Enclose	No
	OR	WO 90/10112	09/1990	WIPO	O'Connor	X			
	PR	WO 98/56977	12/1998	WIPO	Mashburn	X			
	QR	DT 26 04 258	06/1977	Germany					
	RR								
	SR								
	TR								
	UR								
	VR								
	WR								
	XR								

OTHER (Including in this order Author, Title, Periodical Name, Date, Pertinent Pages, etc.)

	YR				
	ZR				
	AAR				
	BBR				
	CCR				
	DDR				

Examiner

Date Considered:

*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

Atty.
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**INFORMATION DISCLOSURE STATEMENT
BY APPLICANT**

Applicant: Lawrence J. O'Connor

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of

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Examiner:

Group Art Unit:

U.S. PATENT DOCUMENTS

Examiner's Initials*		Document Number	Date MM/YYYY	Name (Family Name of First Inventor)	Class	Sub Class	Filing Date (if appropriate)
	AR	4,907,387	03/1990	Turnbull			
	BR	5,204,155	04/1993	Bell et al.			
	CR	5,475,952	12/1995	O'Connor			
	DR	5,613,339	03/1997	Pollock			
	ER	5,794,390	08/1998	Oliveri et al.			
	FR	5,904,011	05/1999	Biro			
	GR	5,913,784	06/1999	Hite			
	HR	6,235,365 B1	05/2001	Schaughency et al.			
	IR	6,357,189 B2	03/2002	Schlisner			
	JR	6,374,555 B1	04/2002	Gusler			
	KR	6,427,395 B1	08/2002	Elsasser et al.			
	LR	6,453,630 B1	09/2002	Buhrts et al.			
	MR						
	NR						

FOREIGN PATENT DOCUMENTS

		Document Number	Date MM/YYYY	Country	Inventor Name	English Abstract		Translation Readily Available	
						Enclosed	No	Enclose	No
	OR								
	PR								
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*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.